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09/311,313	05/13/1999	JOHN G MCBRIDE	10971316-1	1086

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EXAMINER

GARBOWSKI, LEIGH M

ART UNIT

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2825

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 10

Application Number: 09/311,313

Filing Date: May 13, 1999

Appellant(s): MCBRIDE, JOHN G

Daniel R. McClure
For Appellant

EXAMINER'S ANSWER

MAILED

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GROUP 2800

This is in response to the appeal brief filed 22 August 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1, 14 and 19 have been amended subsequent to the final rejection.

Claims 2-13, 15-18, 20-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct with respect to claims 1, 14 and 19. However, appellant's brief presents arguments relating to claims 2-13, 15-18, 22-22 which are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. This issue relates to

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petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter.

See MPEP § 1002 and § 1201.

(7) *Grouping of Claims*

The rejection of claims 14, 19 and 22 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Kuhns, "Automatic Testability Analysis of Analog Circuits and Systems," IEEE 1992, pages 225-231.

6,182,268 B1

McElvain

01-2001

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 14, and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kuhns ["Automatic Testability Analysis of Analog Circuits and Systems"].

Taking claim 14 as exemplary [claims 1 and 19 are considered rejected but such is omitted for sake of brevity], Kuhns discloses a method for determining whether or not an element of a network comprised in an IC is a feedback element, the method comprising the step of: analyzing information relating to the network to determine whether or not an element comprised in the IC is a feedback element [page 230, "Testability Rules" section].

Claims 1, 14, and 19 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by McElvain [U.S. Patent #6,182,268 B1].

Taking claim 14 as exemplary [claims 1 and 19 are considered rejected but such is omitted for sake of brevity], McElvain discloses a method for determining whether or not an element of a network comprised in an IC is a feedback element, the method comprising the step of: analyzing information relating to the network to determine whether or not an element comprised in the IC is a feedback element [column 6, lines 38-65; column 7, lines 15-16].

(11) Response to Argument

Regarding Kuhns, the appellant argues that the reference "does not disclose a method for determining whether or not an element within an integrated circuit is a feedback element. In this regard, it should be appreciated that there is a significant difference between determining whether a given element is a feedback element, and identifying a feedback loop" [pages 4-5]. However, this section of claimed subject matter states: "analyzing information relating to the network to determine whether or not an element comprised in the integrated circuit is a feedback element". There is no "given element" as the appellant argues. Kuhns clearly discloses such an analyzing step, the article states that the tool "will search through the circuit looking for components, or configurations of components that pose unique testing problems. A prime target for this type of analysis is the identification of feedback loops" [page 230, TESTABILITY RULES section lines 1-5]. Thus, an analyzing step pertaining to the particular analysis of feedback is considered to be clearly disclosed by Kuhns [

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throughout the article and particularly noted at page 230 under 'TESTABILITY RULES']. The appellant then argues: "Furthermore, and significantly, the cited portion of the Kuhn's article is completely devoid of any teaching or suggestion that the feedback element includes a transistor" [page 5]. However, the examiner submits that the components (which can also be termed as elements) identified by Kuhns all inherently include transistors, wherein the components (or elements) of integrated circuits are comprised of transistors. Thus, the examiner concludes that Kuhns clearly anticipates the broadly claimed subject matter.

Regarding McElvain, the appellant argues: "there is absolutely no teaching nor mention of a method for determining whether a given element is a feedback element. ... However, it is a far stretch (to say the least) to equate the mere mention of a feedback path to the disclosure of a method for determining whether a given element within a netlist is a feedback element of an integrated circuit, as is specifically claimed" [page 6]. However, there is neither a "given element" nor a "netlist" recited in the claim language. This section of claimed subject matter states: "analyzing information relating to the network to determine whether or not an element comprised in the integrated circuit is a feedback element". McElvain clearly discloses such an analyzing step, the reference describes that a circuit is to be analyzed and that devices or portions of circuitry (which can also be termed as elements) are identified "which possess flip-flops or registers connected to combinational logic through one or more feedback paths" [column 6, lines 44-48; column 7, lines 13-16]. Thus, an analyzing step pertaining to the particular analysis of feedback is considered to be clearly disclosed by McElvain. The appellant

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then argues: "Furthermore, claim 14 requires that the identified feedback element include a transistor" [page 6]. However, the examiner submits wherein that flip-flops, registers, and combinational logic all inherently include transistors; these elements of integrated circuits are comprised of transistors. Thus, the examiner concludes that McElvain clearly anticipates the claimed subject matter.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



LEIGH M. GARBOWSKI
PATENT EXAMINER

Leigh Marie Garbowski
November 7, 2002

Conferees

Mathew Smith [SPE 2825] *mss*
Olik Chaudhuri [SPE 2823] *olc*

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